

CLAIM REJECTIONS

The Examiner rejects claims 1-8 under 35 U.S.C. § 103(a) as being unpatentable over Tsunchara et al. (U.S. Patent No. 6,307,844). This rejection is respectfully traversed.

Applicants respectfully submit that Tsunchara et al. fail to teach or suggest a method for communicating power control information comprising at least the step of “transmitting power control information for a first channel within a portion of a first segment of a pilot channel, the first segment being one of a plurality of repeating segments”, as recited in independent claim 1.

Referring to Tsunchara et al., the only mention of a pilot channel is with respect to Fig. 2, which simply indicates the fact that there is some pilot channel 8 of undetermined dimensions, and in the discussion on column 6, lines 17-33, where a pilot channel is output from an acquisition/spread circuit 150. Nowhere is there disclosed transmitting power control information for a particular channel within a portion of a segment of the pilot channel 8, as recited in claim 1.

The Examiner is directed to the passage supporting Fig. 7 in Tsunchara et al., upon which he relies. As described in column 5, lines 40-47, what is actually shown in Fig. 7 is the insertion of a common transmission power control signal into (or in between) answer packets 110. These answer packets 110 do not represent a pilot channel, and the transmission power control signal 111 does not represent a portion of a first segment of a pilot channel, as is recited in claim 1. For at least these reasons, Applicants submit that independent claim 1, and claims 2-8 dependent thereon, define over Tsunchara et al.

Additionally, Applicants direct the Examiner's attention to two recent cases decided by the Court of Appeals for the Federal Circuit (CAFC), In re Dembiczak, 50 USPQ2d 1614 (Fed.Cir. 1999) and In re Kotzab, 55 USPQ2d 1313 (Fed.Cir. 2000). Both of these cases set forth very rigorous requirements for establishing a prima facie case of obviousness under 35 U.S.C. §103(a). To establish obviousness based on a combination of elements disclosed in the prior art, there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant. The motivation suggestion or teaching may come explicitly from one of the following:

- (a) the statements in the prior art (patents themselves);
- (b) the knowledge of one of ordinary skill art; or in some cases
- (c) the nature of the problem to be solved.

See Dembiczak 50 USPQ at 1614 (Fed.Cir. 1999). In Kotzab, the CAFC held that even though various elements of the claimed invention were present (in two separate embodiments of the same prior art reference), there was no motivation to combine the elements from the separate embodiments, based on the teachings in the prior art.

In order to establish a prima facie case of obviousness under 35 U.S.C. §103(a), the Examiner must provide particular findings as to why the two pieces of prior art are combinable. See Dembiczak 50 USPQ2d at 1617. Broad conclusory statements standing alone are not "evidence".

Here the Examiner is not combining two references, but alleges that a pilot channel is analogous to a control channel in Tsunchara et al., and therefore:

it would have been obvious . . . to transmit the power control information on the pilot channel for each uplink channel assigned to each mobile station so that the mobile transmission power level may be dynamically adjusted (page 3 of OA).

Applicants have read through Tsunchara et al. several times and do not see how in reading Tsunchara et al. one of ordinary skill in art would think that the alleged motivation would come either from Tsunchara et al. explicitly, the knowledge of one of ordinary skill art; or from the nature of the problem to be solved. This is because Tsunchara's focus is to provide a CDMA packet data communication system in which a base station controls the transmission power of each of a plurality of mobile terminals by using a single downlink traffic channel common for all mobile stations.

Moreover, as indicated in the paragraphs bridging cols. 3 and 4, Tsunchara et al. may be summarized as a system in which mobiles transmit reservation packets to a base station, and the base station transmits reservation results to the mobiles in an answer packet 5, upon which the mobiles thereafter transmit their data packets using an uplink traffic channel and time slot designated by the base station. Nowhere in Tsunchara et al. is there suggested that either the single downlink traffic channel of the designated uplink traffic channel constitutes the pilot channel recited in claim 1, or precisely of transmitting power control information within a portion of a first segment of a pilot channel, wherein the first segment is one of a plurality of repeating segments.

Accordingly, Applicants respectfully submit that Claims 1-8 are allowable for at least the reason that the Examiner has failed to establish a proper prima facie case of obviousness under 35 U.S.C. 103(a) in view of Dembiczak and Kotzab.

The Examiner also indicates that certain features are inherent. For example, with respect to claim 4 the Examiner alleges that

“it inherently knows that the times (sic) to transmit the power control information for communication channels such as the design choice to communicate between the subscriber and base station on the priority of data information”.

Applicants have been unable to make sense of this statement, and Applicants cannot determine what evidentiary basis, either explicitly in Tsunchara et al. or within the art, the Examiner is relying on to make this statement of inherency. Initially, Applicants submit that the Examiner's alleged use of inherency is improper in a rejection based on lack of obviousness under 35 U.S.C. §103. An allegation of inherency is proper for an anticipatory rejection. For at least this reason, the rejection is improper.

Moreover, the Examiner apparently takes a broad brush approach to claims 5-8, without providing explicit teachings in Tsunchara et al. or by supplying an evidentiary teaching reference, in alleging that it is inherently known “that channels are voice, data, and video information in the communication channels that is communicated between the base station and mobile station” (OA, paragraph bridging pages 3 and 4).

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993)(reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art).

The Examiner must identify that the extrinsic evidence relied upon to cure any missing descriptive matter upon which he rejects the claims is present in Tsunchara et al. such that it would be recognized by the skilled artisan. See, for example, In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981), which states:

To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

Accordingly, for at least these additional reasons, Applicants submit that Tsunchara et al. fails the test for obviousness as set forth under 35 U.S.C. § 103. Therefore for at least these additional reasons, Applicants kindly submit that claims 1-8 should be indicated as allowable, and that the rejection be withdrawn.

CONCLUSION

In view of the foregoing, Applicants submit that claims 1-8 and the application as a whole is in condition for allowance. Early and favorable notice to that effect is respectfully solicited.

In the event that any matters remain at issue in the application, the Examiner is invited to contact the undersigned at (703) 390-3030 in the Northern Virginia area, for the purpose of a telephonic interview.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-

0750 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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